

Rejection under 35 U.S.C. § 102 in view of Schena et al.

The Examiner rejected Claims 1-20, 22-47 and 49-67 under 35 U.S.C. § 102(a) as being anticipated by Schena et al. (PCT publication number WO 96/30864). The Examiner stated:

The only argument given for Schena is that the invention was conceived and reduced to practice before the publication of the Schena publication. This is not persuasive because claim 66 was rejected by Schena and claim 66 was not listed as a claim conceived and reduced to practice in the declarations. This argument is further not persuasive because the declarations are ineffective in overcoming the Schena reference.

As discussed in a telephonic interview between Examiner Brier and Applicants' attorney, David R. Graham, on February 25, 1999, in the Response to Office Action dated July 3, 1998 (hereinafter, the "previous Office Action response"), Applicants did not argue that the instant invention was conceived and reduced to practice before the effective date of the Schena et al. PCT publication, but, rather, that the Schena et al. PCT publication cannot be used as a reference to reject the claims of the instant application under 35 U.S.C. § 102(a) since the Schena et al. PCT publication was published on a date (October 3, 1996) after the filing the filing date (March 22, 1996) of the instant application. Subsequently, in an Interview Summary summarizing a further telephonic interview between Examiner Brier and Applicants' attorney, David R. Graham, on March 1, 1999, Examiner Brier stated that "Schena is not prior art since the publication date is after applicant's filing date." Applicants therefore request withdrawal of the rejection of Claims 1-20, 22-47 and 49-67 under 35 U.S.C. § 102(a) as being anticipated by the Schena et

al. PCT publication.

Rejection under 35 U.S.C. § 102 in view of Judson or PointCast

The Examiner rejected Claims 1-19, 21-31, 33-46 and 48-67 under 35 U.S.C. § 102(e) as being anticipated by Judson (U.S. Patent No. 5,572,643). The Examiner also rejected Claims 19, 20, 25-28, 32 and 41-47 under 35 U.S.C. § 102(a) as being anticipated by PointCast (as described in the 2-13-96 Wall Street Journal article by Joan E. Rigdon).

The application from which the Judson patent issued was filed on October 19, 1995. The Wall Street Journal article describing the PointCast software was published on February 13, 1996. The instant application was filed on March 22, 1996. In the previous Office Action response, Applicants contended that "[a]t least the subject matter recited in Claims 1, 6, 7, 9, 14, 15, 18-22, 24-29, 31, 32, 41, 42, 45-49, 53, 54 and 61-63 was conceived and reduced to practice prior to October 1995, thus making the Judson patent inapplicable as a reference that can be used to reject those claims, and obviating the rejection of Claims 1, 6, 7, 9, 14, 15, 18, 19, 21, 22, 24-29, 31, 41, 42, 45, 46, 48, 49, 53, 54 and 61-63 as being anticipated by Judson." Similarly, in the previous Office Action response, Applicants contended that "at least the subject matter recited in Claims 1, 6, 7, 9, 14, 15, 18-22, 24-29, 31, 32, 41, 42, 45-49, 53, 54 and 61-63 was conceived and reduced to practice prior to October 1995, thus making the Wall Street Journal article inapplicable as a reference that can be used to reject

those claims, and obviating the rejection of Claims 19, 20, 25-28, 32, 41, 42 and 45-47 as being anticipated by the description of the PointCast software in the Wall Street Journal article." With the previous Office Action response and a Supplemental Response to Office Action dated August 3, 1998, Applicants' submitted a Declaration of Paul A. Freiburger Under 37 C.F.R. § 1.131 (hereinafter, the "Freiburger Declaration"), a Declaration of Philippe P. Piernot Under 37 C.F.R. § 1.131 (hereinafter, the "first Piernot Declaration"), and a Declaration of Giles N. Goodhead Under 37 C.F.R. § 1.131 (hereinafter, the "Goodhead Declaration") in support of those contentions.

In the instant Office Action, the Examiner stated:

The declarations filed on 7/9/98 and 8/7/98 under 37 CFR 1.131 has been considered but is ineffective to overcome the Judson, PointCast, and Schena references.

The evidence submitted is insufficient to establish a reduction to practice of the invention in this country or a NAFTA or WTO member country prior to the effective date of the Judson, PointCast, and Schena references. The declarations do not state FACTS and produce such documentary evidence and exhibits in support thereof as are available to show conception and completion of invention in this country or in a NAFTA or WTO member country. MPEP § 715.07. The declarations do not contain an allegation that the acts relied upon to establish the date prior to the reference were carried out in this country or in a NAFTA country or WTO member country. See 35 U.S.C. 104. MPEP § 715.07(c). The declarations do not produce such documentary evidence and exhibits in support of the alleged FACTS. 37 CFR 1.131(b) and MPEP § 715.07. The declarations fail to allege FACTS which allege the conception and the reduction to practice of having the retrieved content data displayed in an area which will not distract the user from the user's primary task. Independent claims 1, 19, and 46 claim this. Without this allegation and the supporting documentary evidence and exhibits, the rejection of these claims cannot be overcome by the declarations. The declarations fail to allege FACTS which allege the conception and the reduction to

practice of a computer program with acquisition instructions, user interface installation instructions for providing a user interface which allows the user to request a set of content data, content data scheduling instructions, and display instructions. Independent claim 49 claims this. Without this allegation and the supporting documentary evidence and exhibits, the rejection of these claims cannot be overcome by the declarations.

The evidence submitted is insufficient to establish a conception of the invention prior to the effective date of the Judson, PointCast, and Schena references. While conception is the mental part of the inventive act, it must be capable of proof, such as by demonstrative evidence or by a complete disclosure to another. Conception is more than a vague idea of how to solve a problem. The requisite means themselves and their interaction must also be comprehended. See Mergenthaler v. Scudder, 1897 C.D. 724, 81 O.G. 1417 (D.C. Cir. 1897) Documentary evidence and exhibits in support of the alleged FACTS was not provided.

The evidence submitted is insufficient to establish diligence from a date prior to the date of reduction to practice of the Judson, PointCast, and Schena references to either a constructive reduction to practice or an actual reduction to practice. Diligence is lacking because documentary evidence and exhibits in support of the alleged FACTS was not provided.

With this Response to Office Action, Applicants have submitted a second Declaration of Philippe P. Piernot Under 37 C.F.R. § 1.131 (hereinafter, the "second Piernot Declaration"). As discussed in more detail below, Applicants contend that the second Piernot Declaration addresses the Examiner's above-stated remarks regarding the deficiency of the Freiburger Declaration, the first Piernot Declaration and the Goodhead Declaration, and demonstrates the conception and reduction to practice, prior to the effective dates of the Judson patent and the Wall Street Journal article describing the PointCast software, of the invention claimed in various of the pending claims of the

application, as discussed further below.

A system as recited in Claim 1 was conceived and reduced to practice prior to the effective dates of the Judson patent and the Wall Street Journal article describing the PointCast software, as demonstrated by paragraphs 2 and 3 of the second Piernot Declaration. For example, "instructions for enabling a display device to selectively display, in an unobtrusive manner that does not distract a user of the apparatus from a primary interaction with the apparatus, an image or images generated from a set of content data," as recited in Claim 1, were embodied by the computer program shown in Exhibit 1 accompanying the second Piernot Declaration (see, e.g., lines 6 and 23-34 of Exhibit 1 and the accompanying description in paragraph 2 of the second Piernot Declaration). The "set of content data" recited in Claim 1 was embodied by the content data representing an image displayed at a Web site (as also discussed in paragraph 2 of the second Piernot Declaration). The content display system (including the "means for using [a] display device to selectively display the image or images using the set of instructions"), and the apparatus and associated display device, as recited in Claim 1, were embodied by the content display computer (described in paragraphs 2 and 3 of the second Piernot Declaration). The content providing system recited in Claim 1 was embodied by the device or devices (e.g., computer) used to implement a Web site from which content data was obtained. The "means for providing to the content display system a set of instructions for enabling a display device to selectively display an image or images

generated from a set of content data," as recited in Claim 1, was embodied by the application management computer and the conventional hardware and software enabling communication between the content display computer and the application management computer (as discussed in paragraph 3 of the second Piernot Declaration). The "means for receiving" of the content display system, the "means for providing" of the content providing system, the "first communication means," and the "second communication means," as recited in Claim 1, were embodied by conventional hardware and software enabling communication between the content display computer and the application management computer, and conventional hardware and software enabling communication between the content display computer and a Web site (as discussed in paragraph 3 of the second Piernot Declaration).

Systems as further recited in Claims 2 and 3 were also conceived and reduced to practice prior to the effective dates of the Judson patent and the Wall Street Journal article describing the PointCast software, as further demonstrated by paragraph 3 of the second Piernot Declaration. The "application management system" (including the "means for providing one or more sets of instructions for enabling a display device to selectively display an image or images generated from a set of content data") and the "third communication means" recited in Claims 2 and 3 were embodied by the application management computer and the conventional hardware and software enabling communication between the application management computer and the content display computer (as discussed in paragraph 3 of the second Piernot

Declaration).

A system as further recited in Claim 5 was also conceived and reduced to practice prior to the effective dates of the Judson patent and the Wall Street Journal article describing the PointCast software, as further demonstrated by paragraph 2 of the second Piernot Declaration. "[O]perating instructions for beginning, managing and terminating the selective display of the image or images by the content display system," as recited in Claim 5, were embodied by the computer program shown in Exhibit 1 (see lines 6 and 23-34 of Exhibit 1 and the accompanying description in paragraph 2 of the second Piernot Declaration). "[C]ontent display system scheduling instructions for scheduling the display on the content display system of an image or images generated from a set of content data," as recited in Claim 5, were embodied by the computer program shown in Exhibit 1 (see lines 37, 39-41 and 50-54 of Exhibit 1 and the accompanying description in paragraph 2 of the second Piernot Declaration) and by the alphabetical file retrieval feature of Applescript computer programs (see paragraph 2 of the second Piernot Declaration). "[D]isplay instructions for enabling display on the display device of an image or images generated from a set of content data," as recited in Claim 5, were embodied by the computer program shown in Exhibit 1 (see lines 30, 63-78 and 134-161 of Exhibit 1 and the accompanying description in paragraph 2 of the second Piernot Declaration). "[C]ontent data scheduling instructions for providing temporal constraints on the display of an image or images generated from a particular set of content

data," as recited in Claim 5, were embodied by the capability of the DeskPicture computer program (which was executed as part of the execution of the computer program shown in Exhibit 1, see line 32 of Exhibit 1 and the accompanying description in paragraph 2 of the second Piernot Declaration) that enabled specification of how long each set of content data was to be used to generate a display of an image (see paragraph 2 of the second Piernot Declaration).

Systems as further recited in Claims 6 and 7 were also conceived and reduced to practice prior to the effective dates of the Judson patent and the Wall Street Journal article describing the PointCast software, as demonstrated by paragraph 2 of the second Piernot Declaration. "Acquisition instructions," as recited in Claim 7, were embodied by the computer program shown in Exhibit 1 together with capabilities of conventional Internet browser software (see lines 50-54 of Exhibit 1 - in particular, line 53 - and the accompanying description in paragraph 2 of the second Piernot Declaration). "Content data update instructions," as recited in Claim 7, were embodied by the computer program shown in Exhibit 1 (see, e.g., lines 10-22 of Exhibit 1 and the accompanying description in paragraph 2 of the second Piernot Declaration). The "content data acquisition instructions" recited in Claim 6 were embodied as described above for the "acquisition instructions" and "content data update instructions" recited in Claim 7.

A system as further recited in Claim 8 was also conceived and reduced to practice prior to the effective dates of the

Judson patent and the Wall Street Journal article describing the PointCast software, as demonstrated by paragraph 4 of the second Piernot Declaration. As there stated, multiple executable "sets of instructions for enabling a display device to selectively display an image or images generated from a set of content data," as recited in Claim 8, were provided on an application management computer for possible transfer to, and use by, a content display computer.

A system as further recited in Claim 9 was also conceived and reduced to practice prior to the effective dates of the Judson patent and the Wall Street Journal article describing the PointCast software. Claim 9 recites that "one or more content providing systems can provide a plurality of sets of content data to the content display system." As is well known, multiple Web sites that can provide one or more sets of content data that can be used with a system according to the invention were available prior to the effective dates of the Judson patent and the Wall Street Journal article describing the PointCast software.

A system as further recited in Claim 10 was also conceived and reduced to practice prior to the effective dates of the Judson patent and the Wall Street Journal article describing the PointCast software, as further demonstrated by paragraph 4 of the second Piernot Declaration. The first and second clauses of Claim 10 are discussed above with respect to Claims 8 and 9, respectively. As stated in paragraph 4 of the second Piernot Declaration, "[t]he second computer program differed from the first computer program in that the types of format of a set of

content data that could be displayed were different from the types of format of a set of content data that could be displayed by the first computer program," i.e., as recited in the third clause of Claim 10, "at least one of the plurality of sets of instructions for enabling a display device to selectively display an image or images generated from a set of content data can be used to display an image or images generated from only some of the sets of content data." In particular, as seen in lines 134-161 of Exhibit 1 accompanying the second Piernot Declaration and discussed in paragraph 2 of that Declaration, the computer program shown in Exhibit 1 could display sets of content data arranged in either the JPEG or GIF format; the other computer program could not display sets of content data in both of those formats.

Systems as further recited in Claims 14 and 15 were also conceived and reduced to practice prior to the effective dates of the Judson patent and the Wall Street Journal article describing the PointCast software, as further demonstrated by paragraph 2 of the second Piernot Declaration. As there stated, the computer program shown in Exhibit 1 accompanying the second Piernot Declaration (see lines 30, 63-78 and 134-161 of Exhibit 1) enabled display of sets of content data in accordance with either the JPEG or GIF format. As known to those skilled in the art, these are formats for representing a visual image.

A system as further recited in Claim 16 was also conceived and reduced to practice prior to the effective dates of the Judson patent and the Wall Street Journal article describing the

PointCast software, as further demonstrated by paragraph 2 of the second Piernot Declaration. As there stated, a set of content data corresponding to a Web site image previously selected by a user was periodically retrieved and displayed (see lines 10-22 of Exhibit 1). As shown in Exhibit 1 (see lines 12 and 19), this update of the display of a set of content data occurred every 5 minutes. However, as can readily be appreciated, by making the update interval relatively small, updated sets of content data could have been successively retrieved and used to generate a display so that the appearance of a moving image, as recited in Claim 16, was produced.

A system as further recited in Claim 18 was also conceived and reduced to practice prior to the effective dates of the Judson patent and the Wall Street Journal article describing the PointCast software, as further demonstrated by paragraph 2 of the second Piernot Declaration. As there stated, the display device recited in Claim 18 was embodied by a computer.

A system as recited in Claim 19 was conceived and reduced to practice prior to the effective dates of the Judson patent and the Wall Street Journal article describing the PointCast software, as demonstrated by paragraph 2 of the second Piernot Declaration. A "means for acquiring a set of content data from a content providing system," as recited in Claim 19, was embodied by the content display computer operating in accordance with the computer program shown in Exhibit 1 and the Internet browser software (see lines 50-54 of Exhibit 1 - in particular, line 53 - and the accompanying description in paragraph 2 of the second

Piernot Declaration), together with conventional hardware and software enabling communication between the content display computer and a Web site. A "means for selectively displaying on [a] display device, in an unobtrusive manner that does not distract a user of the apparatus from a primary interaction with the apparatus, an image or images generated from the set of content data," as recited in Claim 19, was embodied by the content display computer operating in accordance with the computer program shown in Exhibit 1 (see, e.g., lines 6 and 23-34 of Exhibit 1 and the accompanying description in paragraph 2 of the second Piernot Declaration). The "set of content data" recited in Claim 19 was embodied by the content data representing an image displayed at a Web site. The apparatus and associated display device recited in Claim 19 were embodied by the content display computer. The content providing system recited in Claim 19 was embodied by the device or devices (e.g., computer) used to implement a Web site from which content data was obtained.

The conception and reduction to practice of a system as recited in Claim 19 prior to the effective dates of the Judson patent and the Wall Street Journal article describing the PointCast software is also demonstrated by paragraph 5 of the second Piernot Declaration. A "means for acquiring a set of content data from a content providing system," as recited in Claim 19, was embodied by the content display computer operating in accordance with the computer program shown in Exhibit 2 accompanying the second Piernot Declaration and the Internet

browser software (see line 23 on page 6 of Exhibit 2 and the accompanying description in paragraph 5 of the second Piernot Declaration), together with conventional hardware and software enabling communication between the content display computer and a Web site. A "means for selectively displaying on [a] display device, in an unobtrusive manner that does not distract a user of the apparatus from a primary interaction with the apparatus, an image or images generated from the set of content data," as recited in Claim 19, was embodied by the content display computer operating in accordance with the computer program shown in Exhibit 2 (see, e.g., lines 5-32 on page 2 of Exhibit 2 and the accompanying description in paragraph 5 of the second Piernot Declaration). The "set of content data" recited in Claim 19 was embodied by the content data representing an image displayed at a Web site. The apparatus and associated display device recited in Claim 19 were embodied by the content display computer. The content providing system recited in Claim 19 was embodied by the device or devices (e.g., computer) used to implement a Web site from which content data was obtained.

The conception and reduction to practice of a system as recited in Claim 19 prior to the effective dates of the Judson patent and the Wall Street Journal article describing the PointCast software is also demonstrated by paragraph 7 of the second Piernot Declaration. A "means for acquiring a set of content data from a content providing system," as recited in Claim 19, was embodied by the content display computer operating in accordance with the computer program shown in Exhibit 4

accompanying the second Piernot Declaration and the Internet browser software (see, e.g., lines 67-89 of Exhibit 4 - in particular, lines 77 and 79 - and the accompanying description in paragraph 7 of the second Piernot Declaration), together with conventional hardware and software enabling communication between the content display computer and a Web site. A "means for selectively displaying on [a] display device, in an unobtrusive manner that does not distract a user of the apparatus from a primary interaction with the apparatus, an image or images generated from the set of content data," as recited in Claim 19, was embodied by the content display computer operating in accordance with the computer program shown in Exhibit 4 accompanying the second Piernot Declaration (see, e.g., lines 4 and 21-28 of Exhibit 4 and the accompanying description in paragraph 7 of the second Piernot Declaration). The "set of content data" recited in Claim 19 was embodied by the content data representing an image displayed at a Web site. The apparatus and associated display device recited in Claim 19 were embodied by the content display computer. The content providing system recited in Claim 19 was embodied by the device or devices (e.g., computer) used to implement a Web site from which content data was obtained.

A system as further recited in Claim 20 was also conceived and reduced to practice prior to the effective dates of the Judson patent and the Wall Street Journal article describing the PointCast software, as further demonstrated by paragraph 5 of the second Piernot Declaration. Both the "means for detecting an

idle period of predetermined duration" (see the variable SleepDelay in line 45 on page 6 of Exhibit 2 and the accompanying description in paragraph 5 of the second Piernot Declaration, as well as control option 303 in the display shown in Exhibit 3 accompanying the second Piernot Declaration) recited in Claim 20, and the recitation in Claim 20 that "the means for selectively displaying displays the image or images automatically after detection of the idle period" (see line 4 on page 2 of Exhibit 2 and the following lines 5-32 on page 2 of Exhibit 2) were embodied by the content display computer operating in accordance with the computer program shown in Exhibit 2.

A system as further recited in Claim 21 was also conceived and reduced to practice prior to the effective dates of the Judson patent and the Wall Street Journal article describing the PointCast software, as further demonstrated by paragraph 2 of the second Piernot Declaration. The recitation in Claim 21 that "the means for selectively displaying displays the image or images while the user is engaged in a primary interaction with the apparatus, which primary interaction can result in the display of an image or images in addition to the image or images generated from the set of content data" was embodied by the content display computer operating in accordance with the computer program shown in Exhibit 1 (see line 32 of Exhibit 1 and the associated description in paragraph 2 of the second Piernot Declaration regarding the DeskPicture computer program).

A system as further recited in Claim 22 was also conceived and reduced to practice prior to the effective dates of the

Judson patent and the Wall Street Journal article describing the PointCast software, as further demonstrated by paragraphs 2 and 5 of the second Piernot Declaration. In each of the embodiments of the invention described in paragraphs 2 and 5, respectively, the content display computer included a non-volatile data storage device on which content data was stored at user-designated locations upon transfer of the content data from a data storage device of a Web site after selection of an image at the Web site using the Internet browser software.

A system as further recited in Claim 23 was also conceived and reduced to practice prior to the effective dates of the Judson patent and the Wall Street Journal article describing the PointCast software, as further demonstrated by paragraph 7 of the second Piernot Declaration. A "means for indicating a time at which the means for selectively displaying is to begin display of the image or images" and a "means for activating the means for acquiring at the indicated time, such that the means for selectively displaying displays the image or images in real time as the set of content data is acquired by the means for acquiring" were embodied by the content display computer operating in accordance with the computer program shown in Exhibit 4. As stated in paragraph 7 of the second Piernot Declaration:

Depending on the type of content data acquired, the image was displayed as "wallpaper" (see line 25 and lines 29-49) or in a display area dedicated to the browser software (see line 26 and lines 50-64). ... In the latter case (i.e., lines 26 and 50-64), the computer program shown in Exhibit 4 did not cause content data to be stored on the non-volatile data

storage device of the content display computer, but only used the content data to generate an image display immediately upon acquisition.

This can be seen by comparing the argument lists in lines 63 and 67 of Exhibit 4. The arguments "folderpath" and "fileList" (which identify the user-designated location(s) of the non-volatile data storage device of the content display computer at which content data is stored) were not passed values from line 63. Rather, only a URL list (i.e., an identification of Web sites from which to acquire content data) was passed from line 63 to line 67. Thus, content data to be used in generating a display must be acquired at the time of using that content data to generate the display, as in Claim 23.

A system as further recited in Claim 24 was also conceived and reduced to practice prior to the effective dates of the Judson patent and the Wall Street Journal article describing the PointCast software, as further demonstrated by paragraph 5 of the second Piernot Declaration. A "means for scheduling the display of the image or images generated from a set of content data," as recited in Claim 24, was embodied by the content display computer operating in accordance with the computer program shown in Exhibit 2 accompanying the second Piernot Declaration. In particular, lines 5-12 of page 2 of Exhibit 2 enabled multiple sets of content data to be successively used to generate the display of corresponding image(s), each set of content data being used to generate a display for a specified amount of time (as indicated by the variable DisplayTime in line 5 of page 2 of Exhibit 2 and as specified by a user via control option 304 in

the display shown in Exhibit 3).

A system as further recited in Claim 25 was also conceived and reduced to practice prior to the effective dates of the Judson patent and the Wall Street Journal article describing the PointCast software, as further demonstrated by paragraph 5 of the second Piernot Declaration. A "means for updating the set of content data," as recited in Claim 25, was embodied by the content display computer operating in accordance with the computer program shown in Exhibit 2 accompanying the second Piernot Declaration (see lines 9-30 on page 6 of Exhibit 2 and the accompanying description in paragraph 5 of the second Piernot Declaration).

A system as further recited in Claim 26 was also conceived and reduced to practice prior to the effective dates of the Judson patent and the Wall Street Journal article describing the PointCast software, as further demonstrated by paragraph 5 of the second Piernot Declaration. The recitation in Claim 26 that "the means for updating operates without disrupting use of the apparatus by the user during the time that the means for updating is operating" was embodied by the content display computer operating in accordance with the computer program shown in Exhibit 2. Since, in the computer program shown in Exhibit 2, the update of content data occurred only when the screen saver was turned on (see lines 4-8 on page 6 of Exhibit 2, together with the above-mentioned lines 9-30 on page 6 of Exhibit 2 and the accompanying description in paragraph 5 of the second Piernot Declaration), i.e., when the user was not engaged in an intensive

(or focused) interaction with the content display computer, the means for updating did not disrupt use of the content display computer ("apparatus" in Claim 26) by the user.

A system as further recited in Claim 27 was also conceived and reduced to practice prior to the effective dates of the Judson patent and the Wall Street Journal article describing the PointCast software, as further demonstrated by paragraph 5 of the second Piernot Declaration. The recitation in Claim 27 that "the means for updating obtains the updated set of content data from the content providing system" was embodied by the content display computer operating in accordance with the computer program shown in Exhibit 2 (see lines 9-30 on page 6 of Exhibit 2 and the accompanying description in paragraph 5 of the second Piernot Declaration) and the Internet browser software, together with conventional hardware and software enabling communication between the content display computer and a Web site. In particular, as discussed in paragraph 5 of the second Piernot Declaration, a computer program called "fetchImages" identified the World Wide Web site(s) from which the content data was previously obtained, then caused the browser software to retrieve content data from those site(s).

A system as further recited in Claim 28 was also conceived and reduced to practice prior to the effective dates of the Judson patent and the Wall Street Journal article describing the PointCast software, as further demonstrated by paragraph 5 of the second Piernot Declaration. The recitation in Claim 28 that "the means for updating operates automatically, without intervention

by the user," was embodied by the content display computer operating in accordance with the computer program shown in Exhibit 2 (see lines 9-30 on page 6 of Exhibit 2 and the accompanying description in paragraph 5 of the second Piernot Declaration).

A system as further recited in Claim 29 was also conceived and reduced to practice prior to the effective dates of the Judson patent and the Wall Street Journal article describing the PointCast software, as further demonstrated by paragraph 5 of the second Piernot Declaration. A "means for specifying the location of the content providing system," as recited in Claim 29, was embodied by the content display computer operating in accordance with the computer program shown in Exhibit 2 and the Internet browser software (see the discussion above with respect to Claim 27 of the "fetchImages" computer program). A "means for specifying the time at which an updated set of content data is to be obtained from the content providing system," as recited in Claim 29, was embodied by the content display computer operating in accordance with the computer program shown in Exhibit 2 (see lines 10-17 on page 6 of Exhibit 2, control option 305 in the display shown in Exhibit 3 and the accompanying description in paragraphs 5 and 6 of the second Piernot Declaration).

A system as further recited in Claim 31 was also conceived and reduced to practice prior to the effective dates of the Judson patent and the Wall Street Journal article describing the PointCast software, as further demonstrated by paragraph 5 of the second Piernot Declaration. As there stated, the content display

computer was operated in accordance with version 7 of the MacIntosh™ operating system. As known by those skilled in the art, a computer operating in accordance with version 7 of the MacIntosh™ operating system embodies the means recited in Claim 31, i.e., "means for interrupting a process being implemented by [an] apparatus," "means for storing information representing the state of the process at the time of interruption," and "means for beginning operation of the process, using the stored state of the process, [at the end of the interruption]."

A system as further recited in Claim 32 was also conceived and reduced to practice prior to the effective dates of the Judson patent and the Wall Street Journal article describing the PointCast software, as further demonstrated by paragraph 5 of the second Piernot Declaration. A "means for detecting a predetermined user interaction with the apparatus subsequent to detection of the idle period, wherein occurrence of the predetermined user interaction causes the means for selectively displaying to stop displaying an image or images generated from a set of content data," as recited in Claim 32, was embodied by the content display computer operating in accordance with the computer program shown in Exhibit 2 (see lines 34-43 on page 6 of Exhibit 2 and the description of lines 33-49 on page 6 of Exhibit 2 in paragraph 5 of the second Piernot Declaration). If, during operation of the screen saver, an interaction (e.g., mouse movement) with the content display computer was detected (lines 34-43 on page 6 of Exhibit 2), then operation of the

screen saver was terminated (see line 43 on page 6 of Exhibit 2).

Systems as further recited in Claims 33 and 34 were also conceived and reduced to practice prior to the effective dates of the Judson patent and the Wall Street Journal article describing the PointCast software, as further demonstrated by paragraphs 5 and 6 of the second Piernot Declaration. A "means for displaying one or more control options with the display device while the means for selectively displaying is operating," as recited in Claim 33, was embodied by the content display computer operating in accordance with the computer program shown in Exhibit 2 (see lines 4, 33, and 37 - especially the last - on page 2 of Exhibit 2 and the accompanying description in paragraphs 5 and 6 of the second Piernot Declaration) and conventional software for controlling operation of a computer display device (as known to those skilled in the art) to produce a display as shown in Exhibit 3. A particular control option that enabled the user to request termination of operation of the system, as recited in Claim 34, is shown by the control option 302 of the display shown in Exhibit 3 (see also the description regarding control option 302 in paragraph 6 of the second Piernot Declaration). A "means for selecting a displayed control option," as recited in Claim 33, was embodied by the content display computer and a conventional computer mouse or keyboard operating in accordance with conventional software for controlling operation of such devices (as known to those skilled in the art). A "means for controlling aspects of the operation of the system in accordance with a selected control option," as recited in Claim 33, and,

more particularly, that "the means for controlling terminates operation of the system," as recited in Claim 34, was embodied by the content display computer operating in accordance with the computer program shown in Exhibit 2 (see, e.g., the condition "the hilite of cast "on/off"" in line 38 on page 6 of Exhibit 2).

Systems as further recited in Claims 41, 42, 43 and 45 were also conceived and reduced to practice prior to the effective dates of the Judson patent and the Wall Street Journal article describing the PointCast software, as further demonstrated by paragraph 2 of the second Piernot Declaration. The discussion above with respect to Claims 14, 15, 16 and 18 applies as well to Claims 41, 42, 43 and 45.

Methods as further recited in Claims 46-48 were also conceived and reduced to practice prior to the effective dates of the Judson patent and the Wall Street Journal article describing the PointCast software, as further demonstrated by paragraphs 2 and 5 of the second Piernot Declaration. The discussion above with respect to Claims 19-21 applies as well to Claims 46-48.

A computer readable medium as recited in amended Claim 49 was conceived and reduced to practice prior to the effective dates of the Judson patent and the Wall Street Journal article describing the PointCast software, as demonstrated by paragraphs 5 and 6 of the second Piernot Declaration. "A computer readable medium encoded with one or more computer programs for enabling acquisition of a set of content data and display of an image or images generated from the set of content data on a display device during operation of an attention

manager," as recited in Claim 49, was embodied by a data storage device of the content display computer on which was stored the computer program shown in Exhibit 2 and the Internet browser software. In particular, "acquisition instructions for enabling acquisition of a set of content data from a specified information source," as recited in Claim 49, were embodied by the computer program shown in Exhibit 2 together with capabilities of the Internet browser software (see line 23 on page 6 of Exhibit 2 and the accompanying description in paragraph 5 of the second Piernot Declaration) and conventional software for enabling communication between the content display computer and a Web site. "[C]ontent data scheduling instructions for providing temporal constraints on the display of the image or images generated from the set of content data," as recited in Claim 49, were embodied by the computer program shown in Exhibit 2 (see, for example, lines 5-12 - in particular, the variable DisplayTime in line 5 - on page 2 of Exhibit 2, control option 304 of the display shown in Exhibit 3 and the accompanying description in the second Piernot Declaration). "[D]isplay instructions for enabling display of the image or images generated from the set of content data," as recited in Claim 49, were also embodied by the computer program shown in Exhibit 2 (see lines 13-30 on page 2 of Exhibit 2 and the accompanying description in the second Piernot Declaration).

The conception and reduction to practice of a computer readable medium as recited in amended Claim 49 prior to the effective dates of the Judson patent and the Wall Street Journal article describing the PointCast software is also demonstrated by

paragraph 2 of the second Piernot Declaration. "A computer readable medium encoded with one or more computer programs for enabling acquisition of a set of content data and display of an image or images generated from the set of content data on a display device during operation of an attention manager," as recited in Claim 49, was embodied by a data storage device of the content display computer on which was stored the computer program shown in Exhibit 1 and the Internet browser software.

"[A]cquisition instructions for enabling acquisition of a set of content data from a specified information source," as recited in Claim 49, were embodied by the computer program shown in Exhibit 1 together with capabilities of the Internet browser software (see line 50-54 of Exhibit 1 - in particular, line 53 - and the accompanying description in paragraph 2 of the second Piernot Declaration) and conventional software for enabling communication between the content display computer and a Web site. "[C]ontent data scheduling instructions for providing temporal constraints on the display of the image or images generated from the set of content data," as recited in Claim 49, were embodied by the capability of the DeskPicture computer program (which was executed as part of the execution of the computer program shown in Exhibit 1) that enabled specification of how long each set of content data was to be used to generate a display of an image (see paragraph 2 of the second Piernot Declaration). "[D]isplay instructions for enabling display of the image or images generated from the set of content data," as recited in Claim 49, were also embodied by the computer program

shown in Exhibit 1 (see lines 30, 63-78 and 134-161 of Exhibit 1 and the accompanying description in paragraph 2 of the second Piernot Declaration).

A computer readable medium as further recited in Claim 50 was also conceived and reduced to practice prior to the effective dates of the Judson patent and the Wall Street Journal article describing the PointCast software, as further demonstrated by paragraphs 5 and 6 of the second Piernot Declaration.

"[D]uration instructions for enabling specification of the duration of time that the image or images generated from a set of content data can be displayed," as recited in Claim 50, were embodied by the computer program shown in Exhibit 2 (see line 5 - in particular, the variable DisplayTime - on page 2 of Exhibit 2, control option 304 of the display shown in Exhibit 3 and the accompanying description in the second Piernot Declaration).

A computer readable medium as further recited in Claim 60 was also conceived and reduced to practice prior to the effective dates of the Judson patent and the Wall Street Journal article describing the PointCast software, as further demonstrated by paragraph 2 of the second Piernot Declaration. "[D]isplay instructions ... for enabling display of an image or images generated from a set of content data of a particular type," as recited in Claim 60, were embodied by the computer program shown in Exhibit 1, which enabled display of sets of content data in accordance with either the JPEG or GIF format (see lines 63-78 and 134-161 of Exhibit 1 and the accompanying description in paragraph 2 of the second Piernot Declaration).

A computer readable medium as further recited in Claim 61 was also conceived and reduced to practice prior to the effective dates of the Judson patent and the Wall Street Journal article describing the PointCast software, as further demonstrated by paragraph 2 of the second Piernot Declaration. "[C]ontent data update instructions for enabling acquisition of an updated set of content data from an information source that corresponds to a previously acquired set of content data," as recited in Claim 61, were embodied by the computer program shown in Exhibit 1 (see lines 10-22 of Exhibit 1 and the accompanying description in paragraph 2 of the second Piernot Declaration).

A computer readable medium as further recited in Claim 62 was also conceived and reduced to practice prior to the effective dates of the Judson patent and the Wall Street Journal article describing the PointCast software, as further demonstrated by paragraph 2 of the second Piernot Declaration and Exhibit 1 accompanying that Declaration. "[C]ontent data update instructions ... indicating the location of the information source from which to obtain the updated set of content data," as recited in Claim 62, were embodied by the computer program shown in Exhibit 1 (see the combination of lines 5, 10-22, 29 and 35-62 of Exhibit 1, which caused the user-designated location(s) of the non-volatile data storage device of the content display computer at which content data was stored to be accessed to identify URL(s) of World Wide Web site(s) which were stored together with the corresponding content data, then caused the browser software to retrieve content data from those site(s)).

A computer readable medium as further recited in Claim 63 was also conceived and reduced to practice prior to the effective dates of the Judson patent and the Wall Street Journal article describing the PointCast software, as further demonstrated by paragraph 2 of the second Piernot Declaration and Exhibit 1 accompanying that Declaration. "[C]ontent data update instructions ... indicating a time or times at which to obtain the updated set of content data," as recited in Claim 63, were embodied by the computer program shown in Exhibit 1 (see line 12 of Exhibit 1).

A computer readable medium as further recited in Claim 64 was also conceived and reduced to practice prior to the effective dates of the Judson patent and the Wall Street Journal article describing the PointCast software, as also demonstrated by paragraphs 2 and 3 of the second Piernot Declaration. "[O]perating instructions for beginning, managing and terminating the display on the display device of an image generated from a set of content data," as recited in Claim 64, were embodied by the computer program shown in Exhibit 1 (see lines 6 and 23-34 of Exhibit 1 and the accompanying description in paragraph 2 of the second Piernot Declaration). "[C]ontent display system scheduling instructions for scheduling the display of the image or images on the display device," as recited in Claim 64, were embodied by the computer program shown in Exhibit 1 (see lines 37, 39-41 and 50-54 Exhibit 1 and the accompanying description in paragraph 2 of the second Piernot Declaration) and by the alphabetical file retrieval feature of Applescript computer

programs (see paragraph 2 of the second Piernot Declaration).

"[I]nstallation instructions for installing the operating instructions and content display system scheduling instructions on the content display system," as recited in Claim 64, were embodied by conventional software present on the content display computer (see paragraph 3 of the second Piernot Declaration).

A computer readable medium as further recited in Claim 66 was also conceived and reduced to practice prior to the effective dates of the Judson patent and the Wall Street Journal article describing the PointCast software, as further demonstrated by paragraphs 2 and 3 of the second Piernot Declaration. "A computer readable medium encoded with one or more computer programs for enabling a content display system to selectively display on a display device, in an unobtrusive manner that does not distract a person from a primary interaction with an apparatus associated with the display device, an image generated from a set of content data," as recited in Claim 66, was embodied by a data storage device of the content display computer on which was stored the computer program shown in Exhibit 1. "[O]perating instructions for beginning, managing and terminating the selective display of the image on the display device," as recited in Claim 66, were embodied by the computer program shown in Exhibit 1 (see lines 6 and 23-34 of Exhibit 1 and the accompanying description in paragraph 2 of the second Piernot Declaration). "[C]ontent display system scheduling instructions for scheduling the display of the image on the display device," as recited in Claim 66, were embodied by the computer program

shown in Exhibit 1 (see lines 37, 39-41 and 50-54 Exhibit 1 and the accompanying description in paragraph 2 of the second Piernot Declaration) and by the alphabetical file retrieval feature of Applescript computer programs (see paragraph 2 of the second Piernot Declaration). "[I]nstallation instructions for installing the operating instructions and content display system scheduling instructions on a content display system," as recited in Claim 66, were embodied by conventional software present on the content display computer (see paragraph 3 of the second Piernot Declaration).

Thus, as shown above, the subject matter recited in Claims 1-3, 5-10, 14-16, 18-29, 31-34, 41-43, 45-50, 60-64 and 66 of the present application was conceived and reduced to practice prior to October 19, 1995. Therefore, the Judson patent is inapplicable as a reference that can be used to reject those claims and the rejection of Claims 1-3, 5-10, 14-16, 18, 19, 21-29, 31, 33, 34, 41-43, 45, 46, 48-50, 60-64 and 66 as being anticipated by Judson is thereby obviated. Further, the Wall Street Journal article is also inapplicable as a reference that can be used to reject those claims and the rejection of Claims 19, 20, 25-28, 32, 41-43 and 45-47 as being anticipated by the description of the PointCast software in the Wall Street Journal article is thereby obviated as well.

Judson also does not teach or suggest a system as recited in Claims 4, 11-13, 17, 30, 35-40, 44 or a computer readable medium as recited in Claims 51-59 and 65. In rejecting Claims 1-19, 21-31, 33-46 and 48-67 under 35 U.S.C. § 102(e) as being anticipated

by Judson, the Examiner stated:

The arguments concerning Judson have been considered, but, since Judson displays to the user in way which will not distract the user from a primary interaction, the arguments are not persuasive. At column 6 lines 35-38 Judson describes displaying the additional information as a line along with the downloaded primary information or as described in the preferred embodiment while awaiting receipt of a selected page an informational message is displayed to the user during this period when the user is normally inactive. Clearly Judson teaches the claimed invention.

Claims 4, 11-13, 17, 30, 35-40, 44, 51-59 and 65 are dependent claims which recite myriad limitations that have not been addressed at all by the Examiner, either in the above-quoted section of the present Office Action or in any previous Office Action. In particular, Applicants have previously identified that the aspects of the invention recited specifically in Claims 4, 11-13, 35-40 and 51-58 and 65 are neither taught nor suggested by Judson (see pages 15, 17 and 18-19 of the previous Office Action response). It is incumbent upon the Examiner to particularly address where Judson either teaches or suggests such limitations. A conclusory statement that "Judson teaches the claimed invention" is inadequate to support a rejection of these claims.

Further, Claims 4, 11-13 and 17 each depend upon Claim 1, either directly or indirectly, and so are allowable for the reasons given for the allowability of Claim 1 over Judson (see pages 12-14 of the previous Office Action response). In particular, the Examiner has not addressed at all Applicants' contention that Judson does not teach or suggest "a content display system ... including means for receiving ... a set of

instructions [e.g., a computer program] for enabling a display device to selectively display ... an image or images generated from a set of content data" (emphasis added), as recited in Claim 1.

Additionally, Claims 51-59 and 65 each depend upon Claim 49, either directly or indirectly, and so are allowable for the reasons given for the allowability of Claim 49 over Judson (see pages 18-19 of the previous Office Action response). In particular, the Examiner has not addressed at all Applicants' contention that Judson does not teach or suggest "content data scheduling instructions for providing temporal constraints on the display of [an] image or images generated from [a] set of content data," as recited in Claim 49.

The Wall Street Journal article describing the PointCast software also does not teach or suggest a system as recited in Claim 44. In rejecting Claims 19, 20, 25-28, 32 and 41-47 under 35 U.S.C. § 102(a) as being anticipated by the Wall Street Journal article describing the PointCast software, the Examiner stated:

The argument concerning the Point Cast article at page 22 of applicants amendment failed to consider that the other information listed in the list of types of information which Point Cast software retrieves from the Internet in May of 1996 would include moving video clips (claim 43) and audio (claim 44) since these types of information was present on the Internet prior to May 1996.

The Wall Street Journal article describing the PointCast software does not include any statement about "other information listed in [a] list of types of information which PointCast

software retrieves from the Internet," as contended by the Examiner. More particularly, the Wall Street Journal article describing the PointCast software simply does not teach or suggest that the content data can be audio data, as recited in Claim 44.

In view of the foregoing, Applicants request withdrawal of the rejection of Claims 1-19, 21-31, 33-46 and 48-67 under 35 U.S.C. § 102(e) as being anticipated by Judson (U.S. Patent No. 5,572,643) and withdrawal of the rejection of Claims 19, 20, 25-28, 32 and 41-47 under 35 U.S.C. § 102(a) as being anticipated by PointCast (as described in the 2-13-96 Wall Street Journal article by Joan E. Rigdon).

Rejection under 35 U.S.C. § 102 in view of Pirani et al.

The Examiner rejected Claims 19, 21, 22, 46 and 48 under 35 U.S.C. § 102(b) as being anticipated by Pirani et al. U.S. Patent No. 5,105,184.

The Examiner stated that "[t]he arguments concerning Pirani have been considered, but, since Pirani displays to the user in way which will not distract the user from a primary interaction, the arguments are not persuasive." Since none of Applicants' arguments in the previous Office Action response were directed to whether "Pirani displays to the user in way which will not distract the user from a primary interaction," this part of the Examiner's rationale for continuing to reject Claims 19, 21, 22, 46 and 48 as being anticipated by Pirani et al. is inapposite.

To summarize, in the previous Office Action response, Applicants argued that, unlike Pirani et al., in a system as in Claim 19, content data is not integrated into means (e.g., software) for displaying images generated from content data, nor is content data integrated into means (e.g., software) for providing a primary interaction with an apparatus with which the system is used. Applicants further argued that Pirani et al. do not teach "means for acquiring a set of content data from a content providing system," as recited in Claim 19, but, rather, that advertisements (content data) are integrated into software that is resident on a computer. Finally, Applicants argued that Pirani et al. do not teach or suggest "means for selectively displaying ... an image or images generated from [a] set of content data," as recited in Claim 19, since Pirani et al. do not teach or suggest that the manner in which advertisements (content data) are displayed during operation of particular software can be varied once those advertisements have been integrated into the software.

In the instant Office Action, the Examiner has not addressed these particular arguments made by Applicants in the previous Office Action response. For example, the Examiner states that "Pirani teaches ... means for selectively displaying [i]nformation" However, the Examiner has not pointed out any support for this assertion. In fact, as pointed out in the previous Office Action response, Pirani et al. do not teach "means for selectively displaying ... an image or images generated from [a] set of content data," as recited in Claim 19.

Applicants request that the Examiner reconsider the arguments made in the previous Office Action response concerning the teaching of Pirani et al., since it appears that there has been some confusion regarding the nature of those arguments.

In view of the foregoing, Applicants request withdrawal of the rejection of Claims 19, 21, 22, 46 and 48 under 35 U.S.C. § 102(b) as being anticipated by Pirani et al. U.S. Patent No. 5,105,184.

CONCLUSION

Claims 1-67 were pending. Claims 1-67 were rejected. Claims 49, 53 and 54 have been amended. In view of the foregoing, it is requested that Claims 1-67 be allowed. If the Examiner wishes to discuss any aspect of this application, the Examiner is invited to telephone Applicants' undersigned attorney at (408) 945-9912.

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231, on June 10, 1999.

6-10-99 David R. Graham
Date Signature

Respectfully submitted,

David R. Graham
David R. Graham
Reg. No. 36,150
Attorney for Applicants